

REMARKS

This is in full and timely response to the final Office Action dated October 19, 2005 (Paper No. 20040311). The present Amendment amends claims 1, 3 and 5 and cancels claims 2, 4 and 6. Support for these amendments can be found variously throughout the specification, including, for example, original claims 2, 4 and 6. No new matter has been added.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. Entry of this amendment is respectfully requested. Reexamination and reconsideration in light of the above amendments and the following remarks are respectfully requested.

Claim Rejections- 35 U.S.C. § 103

In the Action, claims 1-6 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,087,888 to Inokuchi ("Inokuchi") in view of U.S. Patent No. 5,659,264 to Ariyoshi et al. ("Ariyoshi"). This rejection is respectfully traversed.

Claim 1

Claim 1 recites, *inter alia*, a power amplifier comprising a first resistance element, a second resistance element with a temperature coefficient smaller than that of the first resistance element, wherein **a resistance value of the second resistance element is variable**.

In contrast, although Inokuchi arguably discloses a second resistor (R2) connected to a controlled FET (Q1), a first resistor (R1) and a third resistor (R3), Inokuchi fails to disclose, teach or suggest *at least* **a resistance value of the second resistance element is variable** as recited in claim 1. *See, e.g.*, col. 5, lines 46-58, Fig. 3 and Fig. 4.

Likewise, although Ariyoshi arguably discloses a first resistor (r1), a second resistor (R5) and a third resistor (R6), Ariyoshi fails to disclose, teach or suggest *at least* **a resistance value of the second resistance element is variable** as recited in claim 1. *See, e.g.*, Figs. 1, 4, 5, 7 and 8.

Accordingly, because Inokuchi and Ariyoshi, either alone or in combination, fail to disclose, teach or suggest each and every limitation of claim 1, a *prima facie* case of obviousness has not been established, and withdrawal of this rejection is respectfully requested. *See, e.g., In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *accord.* MPEP 2143.03.

Moreover, with respect to the rejection of claim 1, it has been conceded in the Action that Inokuchi **does not** disclose a second resistance element with a temperature coefficient smaller than that of the first resistance element. *See, e.g.,* page 3 of Action. Consequently, in order for a *prima facie* case of obviousness to be successfully established, not only must Ariyoshi teach of a second resistance element with a temperature coefficient smaller than that of the first resistance element, but Ariyoshi must provide sufficient motivation to combine this teaching with the circuit of Inokuchi. However, Ariyoshi and Inokuchi clearly lack the necessary motivation or teaching to combine or modify the references in the manner suggested in the Action.

As established by Federal Circuit precedent, to establish a *prima facie* case of obviousness, the Action must provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See, e.g., Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references”); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references”; *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination”); *accord.* MPEP 2143.

It is established law that one “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000) (citing *In re*

Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)). Indeed, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the present case, one of ordinary skill in the art would not be led to modify the circuit of Inokuchi to include a second resistor with a temperature coefficient smaller than that of the first resistor—the resulting circuit would have duplicate temperature drift compensating circuits. Indeed, Inokuchi provides an opposite motivation by disclosing a temperature compensating FET that becomes conductive when the electric potential at its gate node is shifted in the positive direction. *See, e.g.*, col. 6, lines 24-35.

In fact, if one were to combine Inokuchi and Ariyoshi as suggested in the Action, the principle operation of the temperature compensating FET in Inokuchi would be changed because the electric potential at the temperature compensating FET’s gate would have a negative temperature drift coefficient and the temperature compensating FET would not conduct with a rise in temperature rendering the compensating circuitry in Inokuchi useless. As established by the federal courts, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See, e.g., In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); *accord.* MPEP 2143.01. In essence, **the Action has failed to point to any portion of either Inokuchi or Ariyoshi as suggesting that the circuit of Inokuchi should be modified to include a second resistor element with a temperature coefficient smaller than that of the first resistance element.**

Accordingly, because neither Inokuchi nor Ariyoshi provide sufficient motivation for combining and modifying the references in the manner indicated and any attempt to combine the alleged teaching of Ariyoshi, with those of Inokuchi destroys a main object of the Inokuchi invention, the applied art is clearly inadequate, resulting in the Action having failed satisfy the

burden of establishing a *prima facie* case of obviousness. Withdrawal of the rejection of claim 1 is therefore courteously solicited.

Claim 3

Claim 3 recites, *inter alia*, a power amplifier comprising a first resistance element, a second resistance element with a temperature coefficient smaller than that of the first resistance element, wherein **a resistance value of the third resistance element is variable**.

For the reasons essentially similar to those set forth above with respect to the rejection of claim 1, Inokuchi and Ariyoshi, either alone or in combination, fail to disclose, teach or suggest *at least a resistance value of the third resistance element is variable* as recited in claim 3. In addition, for at least the reasons set forth above in connection with the rejection of claim 1, Inokuchi and Ariyoshi lack the requisite motivation to combine the reference teachings, such that the examiner has failed to provide sufficient motivation for combining these references. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 3, and withdrawal of this rejection is respectfully requested.

Claim 5

Claim 5 recites, *inter alia*, a power amplifier comprising a second resistance element with a **temperature coefficient smaller than that of the first resistance element**, a third resistance element with a temperature coefficient smaller than that of the first resistance element wherein **a resistance value of the third resistance element is variable**.

In contrast, it is conceded in the Office Action that Inokuchi fails to disclose a second resistance element with a temperature coefficient smaller than that of the first resistance element and a third resistance element with a temperature coefficient smaller than that of the first resistance element.

Further, although Ariyoshi arguably discloses three resistance elements arranged such that a resistor having a small temperature coefficient is disposed on the side of the dividing resistance closer to the ground, Ariyoshi fails to disclose, teach or suggest at least a second resistance element with a temperature coefficient smaller than that of the first resistance element wherein

a resistance value of the third resistance element is variable as disclosed in claim 5. *See, e.g.*, Fig. 8 and col. 5, lines 39-46. In fact, Ariyoshi teaches that a first resistance element (R5) and a second resistance element (R6) have temperature coefficients equal in value and larger than the temperature coefficient of the third resistance element (r1). *See, e.g.*, col. 5, lines 8-12 and lines 24-26.

Moreover, for the reasons essentially similar to those set forth above with respect to the rejection of claim 1, Inokuchi and Ariyoshi also lack the requisite motivation to combine the reference teachings, such that the examiner has failed to provide sufficient motivation for combining these references.

Accordingly, because Inokuchi and Ariyoshi, either alone or in combination, fail to disclose, teach or suggest each and every limitation of claim 5 and they lack the requisite motivation to combine the reference teachings, a *prima facie* case of obviousness has not been established, and withdrawal of this rejection is respectfully requested. *See, e.g., In re Royka*, 490 F.2d 981; *accord*. MPEP 2143.03.

Conclusion

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-2950 from which the undersigned is authorized to draw.

Dated:

DEC. 19, 2005

Respectfully submitted,

By

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